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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,042	09/29/2000	Yasuyuki Nozaki	07898-059001	1694
7590 01/29/2004				
Stanley PI Fisher REED SMITH LLP 3110 Fairview Park Drive suite1400 Falls Church, VA 22042			EXAMINER MORAN, MARJORIE A	
			ART UNIT 1631	PAPER NUMBER
DATE MAILED: 01/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,042

Applicant(s)

NOZAKI ET AL.

Examiner

Marjorie A. Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 and 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/20/03
8/27/03
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. All objections and rejections not reiterated below are hereby withdrawn.

Election/Restrictions

Claims 7-10 and 12-15 are again withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

An action on the merits of claims 1-6 and 11 follows.

Information Disclosure Statement

The IDS's filed 5/20/03 and 8/27/03 have been considered, with the exception of the Search Reports. Each IDS lists a Search Report, but fails to indicate for what application or publication number the search reports apply, therefore the search reports have not been considered. All other references have been initialed to indicate consideration.

Claim Rejections - 35 USC § 112

Claims 2-4 and 11 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1631

Applicant's arguments filed 11/14/03 have been fully considered but they are not persuasive.

Claim 2 still recites "comparing the expression patterns of two different genes" in line 2. It is unclear if applicant intends --several expression patterns of two different genes-- or --an expression pattern from each of two genes--, therefore the claim is indefinite. Applicant has not amended claim 2 which overcome this rejection nor set forth any arguments specific to this rejection, therefore the rejection is maintained.

Claims 3 and 4 each recite a step of displaying genes according to a predetermined display format, then recite a change in expression format for the displayed genes. Applicant amended claims 2 and 3 to recite "wherein ...genes have the same (different) expression pattern(s) ... but change to..." This amendment does not clarify whether the limitations following "wherein" are intended to be a method step, or whether the "change" in expression pattern is intended to be a limitation of the expression pattern itself, is intended to be a limitation of the "two or more different genes", or is intended to be a limitation of the "predetermined display format" of the displaying step, therefore the claims are still indefinite. Applicant argues that amending "whereby" to "wherein" overcomes the rejection. In reply, it is noted that in the previous office action, the examiner suggested rewriting each claim so that any intended method steps are recited in active, positive language, and such that any other claim limitations are clear; e.g. --displaying results for two or more different genes according to the predetermined display format wherein the genes **are ones which**....-- *Note that language such as "genes are ones which" clearly indicates what the limitation following*

the phrase is intended to limit. Emphasis now added. Applicant should again note that these are suggestions ONLY for claim format and clarity of language, not for claim limitations. Applicant is again reminded that it should be made clear, for each limitation recited, *what* applicant is intending to limit. As it is still unclear what limitation(s) applicant intends, the rejection is maintained.

Amended claim 11 recites the phrase “and displays...” at the end of the claim. It is unclear what is intended to repeat and display; i.e. the apparatus of the preamble, the inputting means, or the arithmetic unit, therefore the claim is indefinite. Further, it is noted that “displays” appears to be a method step; however, claim 11 is directed to an apparatus. As an apparatus (product) is not a method, it is unclear what limitation of the product/apparatus applicant actually intends, and the claim is further indefinite. For these reasons, the rejection is maintained. Applicant is again advised that an apparatus may comprise --means for repeating-- and --means for displaying-- or may comprise --repeating means-- and --displaying means--.

Claim Rejections - 35 USC § 102

Claims 1-6 and 11 are again rejected under 35 U.S.C. 102(b) as being anticipated by WEN et al. (PNAS (1/1998) vol. 95, pp. 334-339).

Applicant's arguments filed 11/14/03 have been fully considered but they are not persuasive. In response to the argument that WEN does not teach clustering of genes based on a predetermined reference value, it is noted that WEN does teach clustering of genes based on a time of development, as set forth in the previous office action. As

the time of development is clearly chosen before clustering of data, the examiner maintains that it is a “predetermined” reference value. In response to the argument that WEN does not teach repeating clustering within the same cluster, it is noted that WEN does teach subclustering. One skilled in the art would recognize that WEN’s “subcluster” is a smaller cluster within the original larger cluster, therefore subclustering may be interpreted as clustering within the “same” (i.e. original) cluster.

In response to the argument that WEN does not teach an inputting means in his apparatus, it is noted that applicant admits on page 7 of the response that “inputting means are necessary to supply data to the machine that runs the software mentioned by WEN reference”, thereby admitting that an inputting means is inherent to WEN’s apparatus.

For the reasons set forth above, the arguments are not persuasive, therefore the rejection is maintained.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

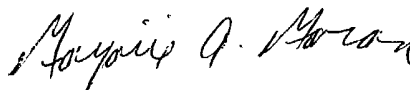
Art Unit: 1631

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon. to Wed, 7:30-4; Thurs 7:30-6; Fri 7-1 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-0722. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0549.



Marjorie A. Moran
Primary Examiner
Art Unit 1631

mam